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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,971	05/23/2006	Yoshihito Kawamura	2006-0785A	7359
513 7590 09/19/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
IP, SIKYIN				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
09/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,971

Applicant(s)

KAWAMURA ET AL.

Examiner

Sikyin Ip

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1 is, claim(s) 1, 3, 4, 6, 8-14, 19, 21, 22, 24, 26-33, and 38, drawn to magnesium alloy contain Zn, Dy, Ho, and Er. The contents of elements have to satisfy expressions

(1) $0.2 \leq a \leq 5.0$;

(2) $0.2 \leq b \leq 5.0$; and

(3) $0.5a-0.5 \leq b$.

(1) to (3).

Group 2 is, claim(s) 2, 5, 7, 20, 23, and 25, drawn to a magnesium alloy contain Zn, Dy, Ho, and Er. The contents of elements have to satisfy expressions (1) to (3).

(1) $0.2 \leq a \leq 3.0$;

(2) $0.2 \leq b \leq 5.0$; and

(3) $2a-3 \leq b$.

Group 3 is, claim(s) 15 and 34 drawn to a magnesium alloy contains Zn, Dy, Ho, Er, Y, and Gd. The contents of elements have to satisfy expressions (4) to (5).

(4) $0 \leq y \leq 4.8$ and

(5) $0.2 \leq b+y \leq 5.0$.

Group 4 is, claim(s) 16 and 35 drawn to a magnesium alloy contains Zn, Dy, Ho, Er, Yb, Tb, Sm, and Nd. The contents of elements have to satisfy expressions (4) to (5).

(4) $0 \leq c \leq 3.0$; and

(5) $0.2 \leq b+c \leq 6.0$.

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Group 5 is, claim(s) 17 and 36 drawn to a magnesium alloy contains Zn, Dy, Ho, Er, La, Ce, Pr, Eu, and Mm. The contents of elements have to satisfy expressions (4) to (5).

$$(4) 0 \leq c \leq 3.0; \text{ and}$$

$$(5) 0.2 \leq b+c \leq 6.0.$$

Group 6 is, claim(s) 18 and 37 drawn to a magnesium alloy contains Zn, Dy, Ho, Er, Yb Tb, Sm, Nd, La, Ce, Pr, Eu, and Mm. The contents of elements have to satisfy expressions (4) to (6).

$$(4) 0 \leq c \leq 3.0;$$

$$(5) 0 \leq d \leq 3.0; \text{ and}$$

$$(6) 0.2 \leq b+c+d \leq 6.0.$$

Group 7 is, claim(s) 39, 41, 45, 47, and 51-57, drawn to a method of producing magnesium alloy contain Zn, Dy, Ho, and Er with steps of casting and plastic working.

$$(1) 0.2 \leq a \leq 5.0,$$

$$(2) 0.2 \leq b \leq 5.0; \text{ and}$$

$$(3) 0.5a-0.5 \leq b.$$

The contents of elements have to satisfy expressions (1) to (3).

Group 8 is, claim(s) 40 and 46, drawn to a method of producing magnesium alloy contain Zn, Dy, Ho, and Er with steps of casting and plastic working. The contents of

$$(1) 0.2 \leq a \leq 3.0;$$

$$(2) 0.2 \leq b \leq 5.0; \text{ and}$$

$$(3) 2a-3 \leq b.$$

elements have to satisfy expressions (1) to (3).

Group 9 is, claim(s) 42 and 48, drawn to a method of producing magnesium alloy contain Zn, Dy, Ho, Er, Yb, Tb, Sm, and Nd with steps of casting and plastic working.

$$(4) 0 \leq c \leq 3.0; \text{ and},$$

The contents of elements have to satisfy expressions (4) to (5). $(5) 0.2 \leq b+c \leq 6.0.$

Group 10 is, claim(s) 43 and 49 drawn to a method of producing magnesium alloy contains Zn, Dy, Ho, Er, La, Ce, Pr, Eu, and Mm steps of casting and plastic working. The contents of elements have to satisfy expressions (4) to (5).

$$(4) 0 \leq c \leq 3.0; \text{ and}$$

$$(5) 0.2 \leq b+c \leq 6.0.$$

Group 11 is, claim(s) 44 and 50 drawn to a method of producing magnesium alloy contains Zn, Dy, Ho, Er, Yb Tb, Sm, Nd, La, Ce, Pr, Eu, and Mm with steps of casting and plastic working. The contents of elements have to satisfy expressions (4) to (6).

- (4) 0 ≤ c ≤ 3.0;
(5) 0 ≤ d ≤ 3.0; and
(6) 0.2 ≤ b+c+d ≤ 6.0.

The inventions listed as Groups 1-11 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The Mg alloy compositions and expressions and steps as set forth above in each group are not the same. Unity does not exist between Groups 1-11.

The inventions listed as Groups 1-11 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claims 1-57 are obvious in view of Hiroyoshi Morisaka et al (search report) accordingly the special technical features linking the groups do not provide a contribution over the prior art and no single inventive concept exists.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikyin Ip whose telephone number is 571-272-1241. The examiner can normally be reached on Monday-Thursday, from 5:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sikyin Ip/
Primary Examiner, Art Unit 1793

September 15, 2008

Application Number**Application/Control No.**

10/579,971

**Applicant(s)/Patent under
Reexamination**

KAWAMURA ET AL.

Examiner

Sikyln Ip

Art Unit

1793